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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,297	02/05/2007	Hans Peter Buchkremer	23611	6761
535 7590 08/18/2009 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER ESSEX, STEPHAN J				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
08/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,297

Applicant(s)

BUCHKREMER ET AL.

Examiner

STEPHAN ESSEX

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/4/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8 and 12 each recite "a porosity" without attributing the "a porosity" to an aspect of the claimed invention. For the purposes of this office action, it assumed that the "a porosity" refers to the porosity of the cathode.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Steele et al. (hereinafter "Steele") (U.S. Pub. No. 2002/0048699A1).

Regarding claims 1-6, Steele teaches fuel cell **1** including a cathode layer **11** comprising a sintered powdered mixture containing a perovskite oxide mixed conductor (cathode material) having a chemical composition according to the formula $\text{La}_{1-x}\text{Sr}_x\text{Co}_y\text{Fe}_{1-y}\text{O}_{3-\delta}$ where $0.5 \geq x \geq 0.2$ and $0.3 \geq y \geq 0$ (see paragraphs 28, 38, 44 and 67).

Regarding claims 8, Steele teaches the mean particle size (average grain size) of the powders of the cathode composition is in the range of from 0.1 to 10 μm (see paragraph 66).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steele as applied to claims 1-6 above.

Regarding claim 7, Steele is silent to a cathode having the exact chemical compositions claimed. However, it has been held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but

are close enough that one skilled in the art would have expected them to have the same properties. See *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (see MPEP § 2144.05).

Regarding claim 9, Steele is silent to the average porosity of the cathode layer. However, the porosity of an electrode layer is known to affect the rate of flow of ions passing through the electrode. Thus, the porosity of the cathode layer is a known result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a known result-effective variable involves only routine skill in the art, and is thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (see MPEP § 2144.05).

Regarding claims 10 and 11, Steele teaches that cathode layer 11 is fabricated from a mixture of LSCF powder and $\text{Ce}_{0.9}\text{Gd}_{0.1}\text{O}_{1.95}$ (CGO) powder (intermediate layer), when sintered, provides a porous composite structure (cathode material and intermediate layer). The LSCF powder has a chemical composition according to the formula $\text{La}_{1-x}\text{Sr}_x\text{Co}_y\text{Fe}_{1-y}\text{O}_{3-\delta}$ where $0.5 \geq x \geq 0.2$ and $0.3 \geq y \geq 0$. The mean particle size (average grain size) of the powders of the cathode composition is in the range of from 0.1 to 10 μm . The cathode layer, the anode layer and the electrolyte layer (anode-electrolyte composite) are then sintered together (see paragraphs 66, 68 and 79). While Steele does not disclose the claimed order of the method steps, it has been held by the courts that the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (see MPEP § 2144.04).

Regarding claim 12, Steele is silent to the average porosity of the cathode layer. However, the porosity of an electrode layer is known to affect the rate of flow of ions passing through the electrode. Thus, the porosity of the cathode layer is a known result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a known result-effective variable involves only routine skill in the art, and is thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (see MPEP § 2144.05).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHAN ESSEX whose telephone number is (571) 270-7866. The examiner can normally be reached on Monday - Friday, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on (571) 272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SJE/

/Dah-Wei D. Yuan/
Supervisory Patent Examiner, Art Unit 1795